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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,319	09/25/2001	Misako Suwa	826.1757	5814
21171	7590	03/01/2004	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			FILIPCZYK, MARCIN R	
		ART UNIT		PAPER NUMBER
		2171		6
DATE MAILED: 03/01/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/961,319	SUWA ET AL.
	Examiner Marc R Filipczyk	Art Unit 2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 February 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 September 2001 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This action is responsive to Applicant's response filed on February 5, 2004 (paper # 5).

Claims 1-22 remain for examination and claims 23 and 24 have been added.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 8, 15 and 22. The segment, "the electronic document" is indefinite. It is not clear whether the electronic document contains the note.

Regarding claims 2-7, 9-14 and 16-21 they depend from 1, 8 and 15 respectively, and therefore contain the deficiencies of those claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 are rejected under 35 U.S.C. 102(e) as best as the Examiner is able to ascertain as being anticipated by Ching (U.S. Patent No. 6,533,168).

Regarding claims 1, 2, 8, 9, 15, 16, 23 and 24 Ching discloses a method, program and system managing a note written on a document, comprising: (figures 1a and 3, item 304) reading as an image a document printed on a paper with a note; (col. 4, lines 9-14, 17 and 18)

extracting information about the note from the read image of the document printed on the paper and a note handwritten on the paper; (col. 4, lines 9-14) and, correlating and electronically storing the document and the information about the note (col. 4, lines 14-17 and 21-24).

Regarding claims 3, 10 and 17, Ching discloses recognizing a character written in the image data of the note (col. 10, lines 32-41).

Regarding claims 4, 11 and 18, Ching discloses the electronic document, a note image and a recognition result of the note image are correlated and electronically stored (col. 10, lines 42-55).

Regarding claims 5, 12 and 19, Ching discloses searching and recognizing with a search keyword and displaying the data (fig. 7, items 704 and 705 and fig. 2a; item 208).

Regarding claims 6, 13 and 20, Ching discloses the location of the note by subtracting an image representing the note from the rest of the document (fig. 3, item 109 and 304).

Regarding claims 7, 14 and 21, Ching discloses location information of the note within the printed document (fig. 3, item 304 and col. 8, lines 2-5).

Response to Arguments

Applicant's arguments filed on February 5, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues on page 8 of the 2/5/2004 response that the electronic version of the original document is not involved as it is not provided to the purchaser.

Examiner disagrees. Ching discloses a system wherein a receipt is printed, user then writes a note on the receipt, the receipt (and/or/with note information) is/are scanned, stored and associated with each other (please see col. 4, lines 9-24). The printed receipt is clearly the original document.

Applicant argues on page 8 of the 2/5/2004 response that, "for example because the original document is available (Applicant's system) it can be changed, something not possible in Ching."

Examiner disagrees. Ching's original document is "available". For additional information please refer to the rejections and response above.

With respect to all the pending claims 1-24, Examiner respectfully traverses Applicant's assertion based on the discussion cited above, as such, Examiner maintains the same rejections.

Conclusion

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156. The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF
February 20, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
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